

UGO NETWORKS, INC.,)	
)	
)	
Opposer,)	
)	Consolidated Opposition No.
)	91/153,578 X
v.)	Appln. Serial Nos.: 76/074,595
)	and 76/075,729
)	
KONAMI CORPORATION,)	Opposition No. 91/158,164
)	Serial No. 76/071,881
Applicant.)	Opposition No. 91/158,129
)	Serial No. 76/074,599
)	Opposition No. 91/158,162
)	Serial No. 76/071,768
)	Opposition No. 91/158,165
)	Serial No. 76/071,879
)	Opposition No. 91/158,201
)	Serial No. 76/203,232
)	Opposition No. 91/158,154
)	Serial No. 76/203,233

**APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S
MOTION TO CONSOLIDATE PROCEEDINGS,
TO RESET DISCOVERY AND TRIAL DATES
AND TO LIMIT DUPLICATIVE DISCOVERY, AND
CROSS-MOTION TO CONSOLIDATE SEPARATELY
THE SIX NEW OPPOSITION PROCEEDINGS AND FOR OTHER RELIEF**

Pursuant to 37 C.F.R. § 2.127 and Fed. R. Civ. P. 42, Applicant Konami Corporation submits this brief in opposition to Opposer's Motion to Consolidate Proceedings, to Reset Discovery and Trial Dates and To Limit Duplicative Discovery ("Opposer's Motion") and submits this Cross-Motion to Consolidate Separately the Six New Opposition Proceedings Nos. 91/158,164; 91/158,129; 91/158,162; 91/158,165; 91/158,201; and 91/158,154, to require Opposer to respond separately to Applicant's Discovery (interrogatories, requests for documents

and requests for admissions) propounded in each of the six new oppositions, to allow the two consolidated proceedings to proceed on separate discovery and trial tracks, subject to the right of either party to seek relief by motion pursuant to Rule 2.122(f); and to reset Discovery and Trial Dates in Consolidated Opposition No. 91/153,578 and in the consolidated proceeding of the six new oppositions requested herein ("Applicant's Cross-Motion"). For the reasons stated in further detail below, Applicant respectfully requests that the Board:

- 1) Deny Opposer's Motion to Consolidate;
- 2) Grant Applicant's Cross-Motion to Consolidate;
- 3) Order the separate consolidation of the six new opposition proceedings, Opposition Nos. 91/158,164; 91/158,129; 91/158,162; 91/158,165; 91/158,201; and 91/158,154;
- 4) Allow the two consolidated proceedings to proceed on separate discovery and trial tracks, subject to the right of either party to seek relief by motion pursuant to Rule 2.122(f);
- 5) Require Opposer to respond separately to Applicant's Discovery (interrogatories, requests for documents and requests for admissions) propounded in each of the six new oppositions;
- 6) Reset Discovery and Trial Dates in Consolidated Opposition No. 91/153,578; and
- 7) Reset Discovery and Trial Dates in the consolidated proceeding of the six new oppositions sought in Applicant's Cross-Motion.

ARGUMENT

A. Applicant's Response to Opposer's Motion is Timely

Opposer served Opposer's Motion by mail on December 24, 2003. Under the applicable rules, Applicant's response to the motion would be due 15 days after service, plus five additional days because the motion was served by mail. 37 CFR § 2.127(a) (15 days); 37 CFR § 2.119(c) (5 extra days after service by mail). Hence, the due date would be 20 days after December 24, 2003, which would be January 13, 2004. Id.

On January 13, 2004, the parties timely filed their Stipulated Motion for Enlargement of Time for Applicant to Respond to Opposer's Motion to Consolidate Proceedings, to Reset Discovery and Trial Dates and To Limit Discovery and to Enlarge Opposer's Time to Respond to Applicant's Outstanding Discovery in which they jointly requested and stipulated that Applicant should have through January 23, 2004 to respond to Opposer's Motion.¹ Although that motion remains pending at the Board, Applicant has timely filed its response within the stipulated deadline that the parties jointly requested.

**B. Consolidated Proceeding No. 91/153,578, Which Has been
Pending For Over Two Years, Should Proceed On its Own Track**

Consolidated Proceeding No. 91/153,578 has been pending since November 2002, when the parent case was filed. Since that time, Applicant has served two sets of interrogatories, document requests and requests for admission. Opposer has served responses, supplemental responses and in the case of interrogatories and document requests, second supplemental responses. Similarly, Opposer has served two sets of interrogatories, document requests and requests for admissions. Applicant has served responses and supplemental responses to Opposer's discovery. Both parties have filed cross-motions to compel. Once those motions are resolved and the parties supplement their discovery responses further, available depositions can proceed. In short, the current consolidated proceeding has progressed further and discovery should be resolved now without further delay after the parties' supplement their discovery responses and take depositions.

In contrast, the six newly filed oppositions were instituted by Orders mailed between October 17 and October 27, 2003. Although Applicant served an initial round of discovery in each of these newly filed oppositions on the day discovery opened or the day thereafter, Opposer

¹ That Stipulated Motion also granted Opposer an additional 10 days beyond the 45-day extension previously granted by Applicant to respond to Applicant's discovery in the six new oppositions.

has obtained extensions of time on consent totaling 55 days and has not yet responded to Applicant's Discovery in any of the six newly filed oppositions. Applicant served its initial discovery in the six newly filed oppositions between November 6 and 17, 2003. In light of the consented extensions of time to respond which Opposer has requested, Opposer's responses currently are due between February 4 and 15, 2004.

In addition, Opposer has not served any discovery on Applicant in the six newly filed oppositions instead waiting two months to file a motion to consolidate and seeking to reset discovery and trial dates. Hence the six newly filed oppositions have not progressed beyond the discovery and responsive pleadings that Applicant previously served, and Opposer has yet to respond to that discovery.

Because of the differences in several of the marks and goods and services at issue in the six newly filed oppositions, Applicant anticipates the need for extensive discovery to prepare its defense to Opposer's spurious claim of a likelihood of confusion between its UGO marks – initialisms for "Underground Online" – and Applicant's foreign language marks – which transliterate to YU-GI-OH, which means King of the Games. Although Applicant's marks are different in appearance, sound, meaning and connotation, Applicant still needs to ensure that it has sufficient time to obtain discovery and evidence concerning each of the likelihood of confusion factors germane to adjudicating each of the six applications at issue in the newly filed oppositions.

Accordingly, Applicant respectfully submits that Consolidated Opposition No. 91/153,578 should proceed to resolution on its own track once the Board rules on the parties pending cross-motions to compel and permits the parties to complete discovery.

C. The Six New Opposition Proceedings
Should Be Consolidated Separately

With the exception of two marks, the marks at issue in the six newly filed oppositions are fundamentally different from Applicant's two applications already at issue in Consolidated Opposition No. 91/153,578. See Exhibit 1. Several of the marks at issue in the six newly filed oppositions also involve different goods and services from those of the Opposer. Id. The case for consolidation has not been made.

The factual issues germane to adjudicating whether a likelihood of confusion exists are different and potentially will involve different evidence, documents and witnesses, as well as different marks, different goods and services, different channels of trade, different consumers, and different conditions under which purchases are made, to name just a few. Consolidation here will serve no purpose other than increasing the burden on Applicant, further delaying its registration of its two marks at issue in Consolidated Opposition No. 91/153,578, and unfairly prejudicing it in obtaining a just adjudication as to the registrability of each of the eight marks covered by Applicant's pending applications. It also will complicate the Board's adjudication of the prior pending consolidated proceeding, clouding the assessment of Applicant's foreign language marks depicted in Kanji characters which plainly are not recognized or understood by the vast majority of the U.S. population.

Because of the differences in the majority of the marks and the different factual issues involved in the six new opposition proceedings, Applicant will need significant time during discovery to obtain documents and depose witnesses to obtain relevant evidence for use in the proceeding. If the new proceedings are consolidated with the currently consolidated proceeding, Applicant will not have sufficient time to obtain evidence germane to its refutation of Opposer's case in chief and in support of Applicant's case in chief for each of the eight applications. As a

result, if consolidation is ordered, Applicant will be prejudiced fundamentally in defending these six new oppositions as well as in defending Consolidated Opposition No. 91/153,578.

Where as here, “there exists a difference of such character and extent in the issues involved as to militate against consolidation,” consolidation should be denied. Izod, Ltd. v. La Chemise Lacoste, 178 USPQ 440 (TTAB 1973). Indeed, in Izod, the Board denied consolidation even though the application in both proceedings was the same.

Consolidation of all eight oppositions together will unfairly bias the Board by increasing the risk that the Board will assess these different marks covering very different goods and services in a similar fashion. Plainly, several of the marks involve goods and services that have no relation whatever to the goods and services provided by Opposer. However, consolidating the proceedings and forcing adjudication of the registrability of each of Applicant’s eight applications on a single record, likely would truncate the Board’s analysis and color its determination of the registrability of each individual application based on the other marks being considered simultaneously. This likely would prejudice Applicant by rendering the Board’s determination of the issues perfunctory and automatic to the damage and detriment of Applicant, the registrability of its marks, and its business.

The compromise Applicant proposed of consolidating the six new oppositions separately from the currently consolidated proceeding makes the most sense in terms of the expenditure of party resources, allowing efficient yet complete discovery concerning the eight applications in total, and facilitating efficient Board adjudication of the eight applications in two consolidated proceedings. The alternative of delaying the current proceeding and truncating a comprehensive consolidated proceeding unduly delays registration of the two applications at issue in the first proceeding and limits Applicant’s ability to take complete discovery in the remaining six

proceedings. Because the first opposition proceeding has been pending for so long, the parties should be permitted to complete discovery after disposition of the pending motions to compel in that proceeding and proceed with an adjudication on the merits.

D. The Parties Can Seek Relief Under Rule 2.122(f) to
Minimize Duplication Between the Two Consolidated Proceedings

If the Board consolidates the six new opposition proceedings separately and allows Consolidated Opposition No. 153,578 and the newly consolidated proceeding to proceed on separate tracks, efficiencies are available to reduce overlap. Specifically, Rule 2.122(f) provides:

- (f) *Testimony from other proceedings.* By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.

37 C.F.R. § 2.122(f).

There are procedural mechanisms available to the parties to streamline discovery and testimony in the separately consolidated proceedings Applicant proposes. As in Izod, the Board could rule that upon a motion made, pursuant to Rule 2.122(f), by either or both parties and granted by the Board, testimony taken in the Consolidated Opposition Proceeding No. 91/153,578 could be used in the later consolidated proceeding of the six newly filed oppositions, “so far as relevant and material, subject, however, to the right of any contesting party to recall or demand the recall of witnesses whose testimony has been taken, and to take other testimony in rebuttal.” See Izod, Ltd., 178 USPQ at 442. The parties can seek to limit duplicative testimony yet ensure full opportunity to take discovery concerning the registrability of each of Applicant’s pending applications and to proffer relevant trial testimony.

**E. Opposer Should Respond to Applicant's Discovery
 Propounded in Each of the Six Newly Filed Oppositions**

In an effort to avoid providing evidence germane to the Board's adjudication of the registrability of each of Applicant's pending applications, Opposer blithely seeks an order to "limit duplicative discovery." This request seeks to limit the evidence that Opposer must disclose relevant to Applicant's defense and case-in-chief in adjudicating the registrability of Applicant's six applications involved in the new oppositions.

As a preliminary matter, Applicant's discovery is similar because it seeks information and evidence concerning the likelihood of confusion factors germane to the Board's adjudication of each mark. As Opposer must recognize, those factors are the same in every case pending before the Board which seeks to preclude registration on Section 2(d) grounds.

Nevertheless, the responses to such discovery will vary, in part, depending upon which of Applicant's eight applications are at issue. Hence, it is critical that Opposer respond to each set of discovery so as to identify the specific responsive information and evidence elicited by Applicant's Discovery. Otherwise, the factual issues which the Board must adjudicate regarding each application will be muddled by information and evidence which may pertain to only one or a few of Applicant's marks. If, as Opposer has requested, the Board allows Opposer to file a single response to Applicant's Discovery in the six newly filed oppositions, Applicant will be denied relevant evidence critical to its case. Similarly, the Board will be left to adjudicate the registrability of several distinct applications based on information and evidence that may have no factual or legal relevance to certain of the applications. The resulting prejudice to Applicant is plain.

F. The Board Should Separately Reset Discovery and Trial Dates in Consolidated Opposition No. 91/153,578 and in the Six Newly Filed Oppositions for Which Applicant Seeks Separate Consolidation

In its November 5, 2003 Motion to Compel filed in Consolidated Opposition No. 91/153,578, Opposer requested that the Board suspend proceedings pending disposition of the motion. Similarly, in its November 26, 2003 Motion to Compel, Applicant requested that the Board suspend proceedings pending disposition of the motion. By Order mailed January 6, 2004, the Board suspended proceedings in Consolidated Opposition No. 91/153,578.

Applicant respectfully requests that once the Board rules upon the cross-motions to compel in Consolidated Opposition No. 91/153,578 and resumes proceedings, that the Board allow the parties a period of three months to complete discovery in Consolidated Opposition No. 91/153,578.

In Opposer's Motion to Consolidate, Opposer has requested that the Board suspend proceedings in the six newly filed oppositions. Applicant agrees that the six newly filed oppositions proceedings should be suspended (subject to Applicant's obligation to respond to Applicant's Discovery in accordance with the agreed due dates).

Applicant respectfully requests that once proceedings are resumed in the six newly filed oppositions, that the Board allow the parties the full six month discovery period to take discovery germane to Applicant's six applications. Although Applicant has been diligent in seeking discovery in the six newly filed oppositions, serving discovery on the day discovery opened or the day thereafter, Opposer has not yet responded to that discovery and has requested repeated extensions of time totaling 55 days beyond the original due dates. As a result, Opposer has deprived Applicant of half of the discovery period. It will be a full three months or more from

the date of service of Applicant's Discovery until Opposer serves any responses to that discovery.

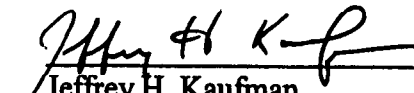
Conclusion

For all of the foregoing reasons, Applicant respectfully requests that the Board:

- 1) Deny Opposer's Motion to Consolidate;
- 2) Grant Applicant's Cross-Motion to Consolidate;
- 3) Order the separate consolidation of the six new opposition proceedings, Opposition Nos. 91/158,164; 91/158,129; 91/158,162; 91/158,165; 91/158,201; and 91/158,154;
- 4) Allow the two consolidated proceedings to proceed on separate discovery and trial tracks, subject to the right of either party to seek relief by motion pursuant to Rule 2.122(f);
- 5) Require Opposer to respond separately to Applicant's Discovery (interrogatories, requests for documents and requests for admissions) propounded in each of the six new oppositions;
- 6) Reset Discovery and Trial Dates in Consolidated Opposition No. 91/153,578; and
- 7) Reset Discovery and Trial Dates in the requested consolidated proceeding of the six new oppositions sought in Applicant's Cross-Motion.

Respectfully submitted,

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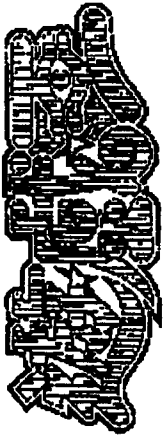

Attorneys for Applicant

Konami Corporation

Dated: January 23, 2004

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**EXHIBITS 1 – MARKS INVOLVED IN
CONSOLIDATED OPPOSITION NO. 91/153,578**

MARK	REG/APPLN. NO.	OWNER	GOODS/SERVICES
UGO	2,450,661	UGO Networks, Inc.	COMPUTER SERVICES, NAMELY COMPUTERIZED ONLINE RETAIL SERVICES IN THE FIELD OF BOXED GAMES AND GAMES RELATED MERCHANDISE; DISSEMINATION OF ADVERTISING FOR OTHERS VIA AN ONLINE ELECTRONIC COMMUNICATIONS NETWORK (IC 41)
UGO	2,519,204	UGO Networks, Inc.	PROVIDING INFORMATION ON COMPUTER GAME AND VIDEO GAME HARDWARE AND SOFTWARE, MUSIC, FILM, TELEVISION, COMICS, ANIMATION AND SPORTS VIA A GLOBAL COMPUTER NETWORK; ENTERTAINMENT SERVICES, NAMELY, PROVIDING ONLINE INTERACTIVE GAMES VIA A GLOBAL COMPUTER NETWORK (IC 35)
UGO	2,562,837	UGO Networks, Inc.	PROVIDING INFORMATION ON TECHNOLOGY VIA A GLOBAL COMPUTER NETWORK; HOSTING WEB SITES OF OTHERS ON A COMPUTER SERVER FOR A GLOBAL COMPUTER NETWORK; DESIGNING AND IMPLEMENTING NETWORK WEB PAGES FOR OTHERS (IC 42)
	76/074,595	Konami Corporation	Computer products, namely, computer game programs; video game cartridges; video game CD-ROMs; video output game units; computer game CD-ROMS; video game programs; video game programs for use with television sets; video game machines for use with television sets; game-playing equipment, namely, joysticks and game controllers (IC 9)
	76/075,729	Konami Corporation	Playing cards; trading cards; calendars; posters; game instruction manuals; computer game instruction manuals; game instructions sheets; scoring sheets; books, namely strategy guides; stationery (IC 16)

KONAMI APPLICATIONS AT ISSUE IN SIX NEW OPPOSITIONS

YU-GI-OH!	76/071,768	Konami Corporation	Computer games, namely, stand-alone video games; hand-held units for playing electronic games; game pieces; action figures; toys, namely, action and play figures and accessories therefor; card games. (IC 28)
YU-GI-OH!	76/071,879	Konami Corporation	Computer products, namely, computer game programs; video game cartridges; video game CD-ROMs; video output game units; computer game CD-ROMS; video game programs; video game programs for use with television sets; video game machines for use with television sets; game-playing equipment, namely, joysticks and game controllers (IC 9)
YU-GI-OH!	76/071,881	Konami Corporation	Playing cards; trading cards; calendars; posters; game instruction manuals; computer game instruction manuals; game instructions sheets; scoring sheets; books, namely, strategy guides; stationery (IC 16)
YU-GI-OH!	76/203,232	Konami Corporation	Providing information about the goods and services of others via the global computer network, (IC 35) satellite communication services, (IC 38) Providing games played through communication by computer terminals, and providing information, images, music and/or sound regarding games; providing computer game software programs, images and music that are downloaded through computer networks, and providing games played through cellular telephone communication and providing information, images, music or sound regarding games; providing computer game programs, images and music that are downloaded through cellular telephone communication, and providing amusement arcade with game facilities; amusement arcades and centers; rental of computer game programs, arcade game machine and providing facilities for recreation activities, namely, amusement arcades and amusement parks; planning managing and holding events for promotion of games; entertainment services, namely, production and distribution of game shows, events featuring voice artists and card game contests; educational services, namely, conducting classes and workshops in the field of training referees for card game contests; providing a computer game that may be accessed network-wide by network users, (IC 41) Providing an on-line computer database in the field of providing information on planning and maintaining computer programs, arcade video game machines, and consumer video game machines (IC 42)

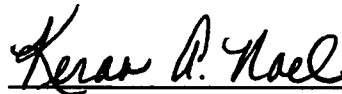
**KONAMI APPLICATIONS AT ISSUE
IN SIX NEW OPPOSITIONS**

	<p align="center">76/074,599</p>	<p align="center">Konami Corporation</p>	<p>Computer games, namely, stand-alone video games; hand-held units for playing electronic games; board game pieces; action figures; toys, namely, action and play figures and accessories therefor; card games (IC 28)</p>
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CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the foregoing APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS, TO RESET DISCOVERY AND TRIAL DATES AND TO LIMIT DUPLICATIVE DISCOVERY AND CROSS MOTION TO CONSOLIDATE SEPARATELY THE SIX NEW OPPOSITION PROCEEDINGS AND FOR OTHER RELIEF and EXHIBIT 1 THERETO to be served on counsel for Opposer, this 23rd day of January, 2004, by sending same via First Class Mail, postage prepaid, to:

William M. Ried, Esquire
WILLKIE FARR & GALLAGHER
787 Seventh Avenue
New York, New York 10019-6099



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91158164
Party	Defendant KONAMI CORPORATION KONAMI CORPORATION 4-3-1 Toranomom Minato-Ku JPX Tokyo, 105-6021
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Submission	APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS, TO RESET DISCOVERY AND TRIAL DATES AND TO LIMIT DUPLICATIVE DISCOVERY, AND CROSS-MOTION TO CONSOLIDATE SEPARATELY THE SIX NEW OPPOSITION PROCEEDINGS AND FOR OTHER RELIEF
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Attachments	231349us123mot.PDF (14 pages)